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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/033,169 | 12/27/2001 | Dmitri Ptchelintsev | 680.0048USU | 5714 |
| 7590 07/01/2004 | | | | |
| Charles N.J. Ruggiero, Esq. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. 10th Floor One Landmark Square Stamford, CT 06901-2682 | | EXAMINER WELLS, LAUREN Q | | |
| | | ART UNIT PAPER NUMBER 1617 | | |

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/033,169 | PTCHELINTSEV, DMITRI | |
| | Examiner | Art Unit | |
| | Lauren Q Wells | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13, 17-19, 21-27 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) 10-13, 17, 18 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-23, 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 10-13, 17-19, 21-27, 34-38 are pending. Claims 10-13, 17-18, 24-27 are withdrawn from consideration, as they are directed to non-elected subject matter ("dermatological signs of aging", the method elected by Applicant, has been deleted from claims 10, 17-18). The Amendment filed 4/22/04, cancelled claims 1-9, 14-16, 20, and 28-33, amended claims 10, 17-19, 21, and added claims 34-38.

The Amendment to the claims filed 4/22/04, wherein claims 1 and 15 were cancelled, is sufficient to overcome the claim objection and 35 USC 112 rejection, in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The terms "poor" in claim 34 (line 3) is a relative term, which renders the claim indefinite. The term "poor" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1617

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gedouin et al. (FR 2,754,447).

Gedouin et al. exemplify a composition comprising 20% mangostin (the ingredient represent by the formula of instant claim 1 and 1,3,6-trihydroxy-7-methoxy-2,8-di(3-methyl-2-butenyl)xanthone) in an emulsion (cosmetically acceptable vehicle, wherein an emulsion is a dispersion), see Table 1 on page 7. Exemplified is applying the composition to the skin for a predetermined time of 15 minutes (effective period of time), see page 10.

The claims are directed to a method of applying a composition comprising mangostin and a cosmetically acceptable vehicle to affected areas of the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently treat dermatological signs of aging (such as loss of skin tone) and/or improving the aesthetic appearance of skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as

Art Unit: 1617

instantly claimed. Additionally, it is respectfully pointed out that page 2 of Gedouin it is taught that applying their composition to the skin decreases the premature aging of the skin.

It is respectfully pointed out that all adult skin contains the appearance of lines/wrinkles and fine lines. Furthermore page 9 of the specification teaches the population of people using the product from 18-41 years old.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 21-23, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gedouin et al. as applied to claims 34, 37-38 above, and further in view of Duggan et al. (2003/0092675).

The instant claims are directed toward methods of applying a composition comprising the compound of instant claim 19 or 34 and a cosmetically acceptable vehicle to the skin.

Gedouin et al. is applied as discussed above. The reference does not teach daily application for 1-2 weeks.

Duggan et al. teach methods of improving the appearance of the skin comprising applying to the skin sunscreen compositions. The compositions are taught as being applied once or twice daily up to two or four weeks. See abstract; page 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of Gedouin et al. as being applied daily for up to two weeks,

as taught by Duggan et al., because Duggan et al. teach that daily application of skin care compositions for a time period of one to two weeks is conventional in the art and because of the expectation of achieving a product that continually protects the user from sun damage and hence, premature aging.

Response to Arguments

Applicant argues, “New claims 34 to 38 distinguish FR ‘447 because it does not disclose treating the skin. FR ‘447 discloses a sunscreen composition for protecting the skin (from sun exposure) rather than treating the skin”. This argument is not persuasive. First, it is respectfully pointed out that protecting the skin is treating the skin. Second, it is respectfully pointed out that a compound and its properties are inseparable, and FR ‘447 teaches the same method of applying to the same areas of skin the same compound in the same effective amount. Whether FR ‘447 labels their method “protecting” and the instant invention labels their method as “treating” is irrelevant, as the methods are the same, thereby resulting in the same effect/end-result.

Applicant argues, “FR ‘447 discloses application of a sunscreen composition to protect the skin from premature aging, but application to the skin to treat one of the selected conditions is not disclosed”. This argument is not persuasive. Again, as pointed out in the above rejection, all adult skin contains the appearance of lines/wrinkles and fine lines (signs of aging). Furthermore page 9 of the specification teaches the population of people using the product from 18-41 years old. And lastly, it is respectfully pointed out that protection from premature aging is treating signs of aging, i.e., wrinkles/lines, by decreasing the occurrence of wrinkles/lines and decreasing their severity.

Regarding the term “poor”, Applicant argues, “The claim language ‘poor skin texture’ could be unambiguously characterized as including inferior quality skin texture”. This argument is not persuasive. It is respectfully pointed out that the term “inferior” alone, is relative, thereby providing no support for the definite nature (not relative nature) of the term “poor”.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER